

REMARKS/ARGUMENTS

Applicants' undersigned representative extend thanks to Patent Examiner Colleen Hoar and Primary Examiner Jeff Carlson for the courtesy of a telephone interview on October 20, 2008. It is believed great progress was made in resolving issues with respect to claiming the disclosed invention so as to be patentable over the cited art. Claim amendments are presented in this Amendment, which is filed with the accompanying Request for Continued Examination (RCE). Entry of the Amendment and further examination are respectfully requested.

Claims 1-4 and 6-23 are pending (claim 5 was previously canceled). In the Office Action dated July 8, 2008, all the pending claims were rejected under 35 U.S.C. § 102(b) as anticipated by Davis (U.S. Pat. No. 6,269,361).

Interview Summary

During the telephone interview, the pending claims and Davis were discussed. Applicants noted that Davis relates to ranking the listing of search results from an Internet search engine (see the Abstract of Davis) so that advertisers who want to promote their own Web site may bid on keywords and thereby influence the listing of their Web site in the list of search results, such that then when a user clicks on their Web site link in the results listing, the search engine provider will receive payment from the advertiser (see Davis at col. 5, lines 18-30). Thus, Applicants asserted that Davis is directed to rank ordering of search results and does not relate to the claimed feature of receiving a computer client request for a document and returning that requested document along with an advertisement (using claim 1 as an exemplary claim; see also claims 11 and 22).

Although Applicants continue to assert that Davis does not provide the invention as previously claimed, such as features (b), (c), and (e) in claim 1 as previously presented, during the telephone interview claim amendments were discussed that it is believed more particularly point out the patentable features of the invention. These amendments are presented herein and are discussed below.

Claim Amendments

Three types of claim amendments are presented in this document. The amendments are presented in accordance with the telephone discussion noted above.

"requested preexisting document"

Examiner Hoar noted that Figure 7 of Davis is an illustration of a Web search results page displayed in a browser window, and in that sense, the results page could be characterized as a "requested document" generated "in response to" a search query. As noted, search engine results displays are generated on-the-fly in response to a search query string. It is submitted that a search engine results page displayed in a browser window should not be read as the equivalent of a "requested document" as recited in the claims. As noted in the discussion, it seems axiomatic that a "request for ... a document" cannot have as its object a document that is not currently in existence (such as a search results page). Nevertheless, for advancing prosecution, the independent claims have been amended to recite that the claimed system receives a request for a "preexisting document", to emphasize that the requested document is not a document created on-the-fly, such as the search results page of Davis at Figure 7. For example, in claim 1, see the amendments to subparagraphs (b), (c), and (e). Similar amendments were made to the other independent claims (i.e., claims 11 and 22).

"in response to" words in the requested document

During the discussion, it was asserted that the claims do not make it clear that words in the requested document must be ascertained before matching words in the advertisements can be identified for selection of advertisements. The claim amendments make it clear that the advertisements are selected "in response to [identifying key words in the advertisements that match words] in the requested preexisting document". That is, words in the requested document must be known prior to selection of advertising, if the selection is performed in response to the identification of matching words. See, for example, subparagraph (c) of claim 1. Similar amendments were made to the other independent claims. In contrast, for Davis, the selection would have to be in response to analysis of the document (i.e., analysis of the search results page) and subsequent comparison against the advertisements.

"delivering [the advertisement] along with the requested preexisting document in response to the received request"

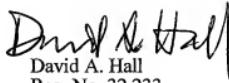
This change makes it clear that the advertisement is delivered along with the requested document and in response to the received request. That is, this feature distinguishes Davis, because the Davis search results page is the only "document" that is returned. During the discussion, it was asserted that Davis could, upon clicking a link, return an additional "requested document", but this claim amendment specifies that the requested document and the selected advertisement are both returned in response to the received request. See, for example, subparagraph (e) of claim 1. Similar amendments were made to the other independent claims. Thus, the pending claims are distinguished from Davis.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application, as amended, are in condition for allowance, and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100.

Respectfully submitted,



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